

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OSCAR SOTELO and
JUAN L. GUERRERO

Appeal No. 97-2119
Application 08/263,825¹

ON BRIEF

Before HAIRSTON, MARTIN, and HECKER, Administrative Patent
Judges.

HAIRSTON, Administrative Patent Judge.

¹ Application for patent filed June 21, 1994. According to applicants, the application is a continuation-in-part of Application 07/945,906, filed September 17, 1992.

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DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 14.

The disclosed invention relates to a timer for producing a series of output signals to an apparatus for automatically dispensing feed at a predetermined relation to lunar transit time.

Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A timer comprising an output and means for producing a series of signals on the output at a predetermined relation to lunar transit time, the signals of the series being spaced apart by an average of about twenty four hours fifty one minutes.

The references relied on by the examiner are:

Carlson	4,035,661	July 12,
1977		
Fishman et al. (Fishman)	5,160,068	Nov.
3, 1992		
	(filed Oct. 11,	
1989)		

Claims 1 through 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Carlson.

Claims 8 through 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fishman in view of Carlson.

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Reference is made to the brief and the answer for the
respective positions of the appellants and the examiner.

OPINION

The obviousness rejection of claims 1 through 14 is reversed.

Carlson discloses a programmable timer for selectively timing the occurrence of electrically controllable events (Abstract; column 1, lines 13 through 18; column 1, lines 40 through 43; column 6, lines 8 through 12; column 6, lines 53 through 60).

Based upon the teachings of Carlson, the examiner is of the opinion that "[t]he selection of a particular time period for producing the output signal would be an obvious matter of choice to one skilled in the art" (Answer, page 4) and that "no patentable subject matter is present in applicant's [sic] claims, as the timer of the patent is capable of providing a signal at lunar transit time, if such selection is desired" (Answer, page 5).

Appellants argue (Brief, page 7) that:

[T]he Examiner is confusing what Carlson's timer is capable of with what it would be obvious to do with Carlson's device. The appropriate question is whether it would be obvious to set Carlson's device to go off at some relation to lunar transit time and then repeat it again at some relation to lunar transit time some twenty four hours fifty one

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minutes later. So far as applicant can see, the Examiner has not addressed this question.

We agree with appellants that Carlson neither teaches nor would have suggested to one of ordinary skill in the art the setting of a timer at a predetermined relation to lunar transit time.² While Carlson's timer may be capable of being modified to run in the manner set forth in the claims, there must be a suggestion or motivation in the reference to do so. In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). In the absence of such a suggestion in the applied reference, and the lack of a convincing line of reasoning by the examiner, it would not have been a matter of design choice to have the timer in Carlson provide "a signal at lunar transit time." Accordingly, the 35 U.S.C. § 103 rejection of claims 1 through 7 is reversed.

Turning to the obviousness rejection of claims 8 through 14, the examiner states (Answer, page 4) that in view of the teachings of Carlson, "one of ordinary skill in the art would

² It is not clear from the disclosure (specification, page 1) whether the Corpus Christi Caller Times article is prior art to appellants. If the article is prior art to appellants, then the examiner is invited to explore the use of such article in a prior art rejection.

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be taught how to select repeated timing intervals for
actuating a load, specifically, the feed hopper of Fishman et
al."

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Appellants concede (Brief, page 8) that Fishman discloses
"a hopper and means for dispensing feed from the hopper."

Although Fishman discloses a timer for controlling
the dispensing cycle of a hopper (Figure 1; column 2, lines 6
through 10; column 6, lines 39 through 43), we agree with
appellants that "none of the references relied upon by the
Examiner have anything to do with lunar transit time" (Brief,
page 9). Thus, the obviousness rejection of claims 8 through
14 is reversed.

DECISION

The decision of the examiner rejecting claims 1 through
14 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JOHN C. MARTIN)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
STUART N. HECKER)	

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Administrative Patent Judge)

KWH:svt

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